

Support for the amendment to independent claims 18, 40, and 43 to recite a cosmetically acceptable medium is found, e.g., in originally filed claim 1 and at page 15, lines 1-8 of the present application. Support for amending independent claim 43 to recite "prior to application" is based on a skilled artisan's understanding that the cosmetic composition is pressurized in an aerosol container prior to application. Support for adding new claims 46-48, reciting that the cosmetic composition is chosen from a hair setting lotion, a blow drying lotion, a fixing composition, and a styling composition, is found, e.g., at page 17, lines 4-6.

Accordingly, no new matter has been added by the amendments and no estoppels are intended thereby.

Response to § 112 Rejection

Claims 2 [sic, 20], 42, and 45 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons set forth at page 2 of the Office Action. Although Applicants disagree with the rejection, in order to advance prosecution, claims 20, 42, and 45 have each been amended to even more clearly recite the present invention and to eliminate the language objected to by the Examiner. In this regard, any amendments to the claims which have not been specifically noted as being made to overcome a rejection based upon the prior art, should be considered to have been intended to clarify the claims and not narrow the claims, such that no estoppel should be deemed to attach thereto.

In view of the above, Applicants respectfully request that this ground of rejection be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Response to § 102 Rejection

Claims 18-21, 24-30, 39, 40, and 42 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,721,026 to FEDER et al. ("FEDER"). The Examiner asserts that FEDER discloses a composition comprising an oil-in-water base emulsion of an α,ω -(dihydroxy)polydiorganosiloxane and an aqueous latex of an organic copolymer. The Examiner further asserts that the composition is disclosed for cosmetic use for the treatment of hair. Applicants respectfully traverse the rejection.

The present claims, as amended, recite a cosmetic composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising at least one non-aminated silicone α,ω -disilanol, and a cosmetically acceptable medium. For a reference to properly anticipate a claim, the identical invention must be shown in the reference in as complete detail as is contained in the claim. M.P.E.P. § 2131.

In the present case, FEDER discloses that its composition includes an oil-water-emulsion, an aqueous dispersion of an organic (co)polymer, a crosslinking agent, a nonsiliceous inorganic filler, and optionally, a metal curing catalyst, (col. 3, lines 43-58). Accordingly, Applicants respectfully submit that FEDER does not disclose the recited combination, including a cosmetically acceptable medium.

Further, although FEDER generally mentions the possibility of using its aqueous silicone dispersions in cosmetic compositions, as noted in the Office Action, most of the disclosure of FEDER is directed to non-cosmetic uses such as paint, silicone elastomer seals, water-repellent coatings, coating pharmaceutical or plant-protection active

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

substances, coating cork stoppers, and coating kitchenware. See e.g., col. 10, lines 29-59.

Therefore, FEDER fails to disclose the identical invention in as complete detail as is contained in the present claims. In particular, Applicants respectfully submit that FEDER fails to disclose a cosmetic composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising at least one non-aminated silicone α,ω -disilanol, and a cosmetically acceptable medium.

In view of the above, Applicants respectfully request that this ground of rejection be withdrawn.

Response to § 103 Rejection

Claims 18, 22, 23, 31-38, 40, 41, and 43-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over FEDER in view of U.S. Patent No. 6,024,946 to DUBIEF et al. ("DUBIEF") and in view of U.S. Patent No. 6,153,179 to BLANKENBURG et al. ("BLANKENBURG"), or U.S. Patent No. 6,106,577 to AUDOUSSET et al. ("AUDOUSSET"). The Examiner concedes that FEDER fails to disclose preferred polymer particles, propellants, a hair setting lotion, and a process of rinsing hair. However, she relies on the secondary references to remedy these deficiencies.

With respect to DUBIEF, the Examiner asserts, inter alia, that DUBIEF discloses hair treatment compositions comprising polymer particles and propellants. DUBIEF's composition may be a "hair setting lotion to be used before or after perming." See Office Action at page 4, lines 11-21 and page 5, lines 16-17. The Examiner then argues that it would have been obvious to incorporate these ingredients of DUBIEF into the composition of FEDER at least because FEDER teaches a composition to be used with

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

permanent waving and both documents teach compositions comprising the same active constituents for the treatment of hair such that one would expect the two compositions to exhibit similar properties. See Office Action at page 5, lines 10-21.

The Examiner relies on BLANKENBURG for its disclosure of a hair setting lotion and propellants. See Office Action at page 4, line 22 to page 5, line 2. She argues that it would have been obvious to substitute the film-forming polymers of BLANKENBURG for the organic copolymers of FEDER to obtain a composition comprising the insoluble polymers of present claims 22 and 23, at least because BLANKENBURG teaches that its composition has good setting properties, good washing-out ability, low stickiness and the ability to form clear films. See Office Action at page 6, lines 1-12.

Finally, the Examiner asserts that AUDOUSSET discloses a composition containing a film-forming polymer aqueous dispersion and non-melanic pigment for temporarily dyeing hair. See Office Action at page 5, lines 3-4. She argues that it would have been obvious to substitute the film-forming polymers of AUDOUSSET for the organic copolymers of FEDER to obtain a composition comprising the insoluble polymers of present claims 22 and 23, at least because AUDOUSSET teaches that compositions comprising its film-forming polymers are particularly stable. See Office Action at page 6, lines 1-9.

Applicants respectfully traverse the rejection.

As argued above, FEDER fails to disclose or suggest a cosmetic composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising at least one non-aminated silicone α,ω -disilanol, and a cosmetically acceptable medium. In this regard, Applicants note that cancelled claim

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

39, which recited a cosmetically acceptable medium, was not rejected under the present obviousness rejection.

Furthermore, FEDER fails to disclose certain elements of the claims as discussed above. Applicants maintain that there would have been no motivation to substitute the missing ingredients from the secondary documents into FEDER to obtain the present invention, in part because FEDER is not primarily directed to cosmetic compositions.

Specifically, the problems disclosed in FEDER regarding the prior art compositions have nothing to do with cosmetic compositions. See e.g., col. 2, lines 10-27. And, as noted above, most of the disclosure of FEDER is directed to non-cosmetic uses such as paint, silicone elastomer seals, water-repellent coatings, coating pharmaceutical or plant-protection active substances, coating cork stoppers, and coating kitchenware. FEDER discloses that the objectives of its invention include satisfactory adhesiveness to substrates such as stone, concrete, mortar, metals, steel, aluminum, fibro-cement, enamels, ceramics, and plastics. See col. 3, lines 24-27. FEDER also discloses other objectives, such as gas permeability and abrasion resistance, that appear to be directed to compositions other than cosmetic compositions. See col. 3, lines 16-37. Since the problems, objectives, and compositions of FEDER are primarily directed to compositions other than cosmetic compositions, Applicants respectfully submit that a skilled artisan would not have been motivated to combine the teachings of FEDER with the hair treatment teachings of the secondary documents.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Regarding FEDER and DUBIEF, Applicants note that the asserted motivation to combine the teachings of these documents is partially based on the assertion that DUBIEF discloses a hair setting lotion. Applicants do not see such a disclosure; only a disclosure at col. 7, lines 57-61, of lotion to be used before or after shampooing, perming, dyeing, bleaching, or straightening. Applicants respectfully submit that these are not instances of "setting" hair. Hair setting is a mechanical (non-chemical) process of changing a hair style and is not even suggested by DUBIEF. Therefore, Applicants respectfully submit that the motivation to combine the teachings of FEDER and DUBIEF relied on in the Office Action is improper at least for this reason.

Moreover, there is no motivation to combine the teachings of FEDER and DUBIEF because the composition of FEDER is directed to an α,ω -(dihydroxy)polydiorganosiloxane emulsion, whereas DUBIEF does not disclose an α,ω -(dihydroxy)polydiorganosiloxane, let alone a siloxane that is in an emulsion. Although DUBIEF discloses an o/w emulsion of acrylamide/sodium 2-methyl propanesulfonate acrylamide copolymer, DUBIEF fails to disclose or suggest that its octamethylcyclotetrasiloxane dimethiconol and dodecamethylcyclopentasiloxane are in an emulsion. The failure of DUBIEF to teach a composition comprising an emulsion comprising a siloxane is notable in contrast with its specific reference to emulsions of other polymers. See, e.g., Examples 1, 2, 7, and 10 of DUBIEF. Because of this basic difference between FEDER and DUBIEF, Applicants respectfully submit that there is no motivation to combine the teachings of these documents.

Concerning BLANKENBURG and AUDOUSSET, there is no motivation to combine the teachings of these documents with those of FEDER for reasons similar to

FINNEGAN
ENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

those discussed above for DUBIEF. In particular, BLANKENBURG and AUDOUSSET fail to disclose an α,ω -(dihydroxy)polydiorganosiloxane, let alone a siloxane that is in an emulsion. Because of this basic difference between FEDER in comparison with BLANKENBURG and AUDOUSSET, there is no reasonable expectation that the film-forming polymers of BLANKENBURG and AUDOUSSET would even function in the composition of FEDER.

Even if a *prima facie* case of obviousness were established in this case, the claimed compositions and processes of the present invention yield unexpected results sufficient to rebut a prima facie case of obviousness, contrary to the statement on page 7 of the Office Action. The Federal Circuit has held that a showing of substantially improved results for an invention and a statement that results were unexpected suffice to establish unexpected results absent evidence to the contrary. *In re Soni*, 34 USPQ2d 1684, 1687-1688 (Fed. Cir. 1995).

Here, the present specification states that the results of the present invention are surprising. See e.g., page 3, lines 24-26. The present specification also provides data indicating these unexpected results. See Examples 1-3. In particular, Examples 1-3 show substantially improved results for disentangling, softness, and feel.

The Examiner argues that the data of Examples 1-3 is unpersuasive because "(a) the data merely demonstrates the effectiveness of the instant composition as a hair lotion, which is seen to be an expected result based on the prior art; and (b) the data sets forth a side by side comparison of the instant composition with two other similar compositions, but fails to compare and contrast the properties of the instant

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

compositions with the compositions of similar make-up." Office Action at page 7, lines 2-6. Applicants disagree.

In response to Examiner's point (a), as noted above, the results of the present invention are surprising. The results of the present invention not expected from the prior art. In this regard, the prior art fails to disclose the recited cosmetic composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising at least one non-aminated silicone α,ω -disilanol, and a cosmetically acceptable medium. Since the prior art does not disclose the recited composition, it cannot be said that the results of the invention are expected from the prior art. Therefore, Applicants respectfully submit that the results of the present invention are not expected.

In response to (b), Applicants note that the data of Examples 1-3 includes a comparison of four inventive compositions with seven comparative compositions. In particular, the disentangling, softness, and feel of inventive composition A of Example 1 are compared with that of comparative compositions B-D of Example 1. Similarly, the disentangling, softness, and feel of inventive compositions A and B of Example 2 are compared with that of comparative compositions C and D of Example 2. Furthermore, the disentangling, softness, and feel of inventive composition A of Example 3 is compared with that of comparative compositions B and C of Example 3. Each of these comparisons establishes substantially improved results for the present invention.

In view of the above, Applicants respectfully submit that the present application includes data showing substantially improved, i.e., unexpected, results. If the Examiner does not agree, further clarification of her position is requested.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

In view of the above, Applicants respectfully request that this ground of rejection be withdrawn.

Conclusion

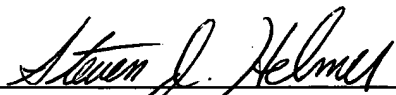
In view of the foregoing amendments and remarks, each argument taken independently, Applicants submit that the present invention is allowable over the documents cited against this application. Applicants request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 10, 2002

By: 
Steven J. Helmer
Reg. No. 40,475

352199_1

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX

18. (Amended) A cosmetic composition comprising:

(a) an aqueous dispersion comprising at least one insoluble polymer particle;

[and]

(b) an emulsion comprising at least one non-aminated silicone α,ω -disilanol; and

(c) a cosmetically acceptable medium.

20. (Amended) A composition according to claim 18, wherein the at least one insoluble polymer particle is chosen from copolymers [of] formed from alkyl acrylate, alkyl methacrylate, one or more ethylenic carboxylic acids having from 3 to 5 carbon atoms, one or more salts of ethylenic carboxylic acids having from 3 to 5 carbon atoms, and mixtures thereof.

22. (Amended) A composition according to claim 20, wherein the at least one insoluble polymer particle is [chosen from] ethyl acrylate/methyl methacrylate/methacrylic acid/acrylic acid [copolymers] copolymer.

40. (Amended) A process for treating keratinous substances comprising applying to the keratinous substances a cosmetic composition comprising:

(a) an aqueous dispersion comprising at least one insoluble polymer particle;

[and]

(b) an emulsion comprising at least one non-aminated silicone α,ω -disilanol; and

(c) a cosmetically acceptable medium.

42. (Amended) A process according to claim 40, wherein the keratinous substances are [chosen from] hair.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

43. (Amended) A process for treating keratinous substances comprising applying to the keratinous substances a cosmetic composition comprising:

(a) an aqueous dispersion comprising at least one insoluble polymer particle,

(b) an emulsion comprising at least one non-aminated silicone α,ω -disilanol,

[and]

(c) at least one propellant, and

(d) a cosmetically acceptable medium,

wherein the cosmetic composition is pressurized in an aerosol container prior to application.

45. (Amended) A process according to claim 43, wherein the keratinous substances are [chosen from] hair.

FINNEGAN
ENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com